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09/808,550	03/14/2001	Ric Joranlien	1207	3826

7590

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EXAMINER

SORKIN, DAVID L

ART UNIT

PAPER NUMBER

1723

10

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/808,550

Applicant(s)

JORANLIEN ET AL.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 22 contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 22 is directed toward the "paddle" embodiment of Fig. 5. It is considered that there is no support in the originally filed specification for the further limitations of claim 22, in combination with the limitations of claim 1, from which claim 22 ultimately depends. Specifically, it is considered that the newly added limitation of claim 1, "said first extremity being disposed in adjacent spaced relationship relative to said second end of said first portion such that feed moves from said housing toward said opening" was not associated with the paddle embodiment by the originally filed instant specification.

3. Claims 29, 40 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. These claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 has been amended to

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require a drive pinion and intermeshing final driven wheel. The further limitations of claims 29, 40 and 41 are directed to sprocket and chain embodiments. These sprocket limitations were not disclosed in the instant specification as originally filed, in combination with the intermeshing pinion limitations of claim 1. Instead, the intermeshing pinion arrangement is one embodiment (see Fig. 7) and the sprocket and chain arrangement is an alternative embodiment (see Fig. 8).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 6-11, 26-35, 40 and 41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Because "a final driven wheel" is recited in claim 1, and again in claim 2, it is unclear to which of the two wheels subsequent references to "said final driven wheel" refer.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

7. Claims 1-20 and 22-45 are rejected under 35 U.S.C. 102(f):

Background

A. Original application 09/562,167 (grand-parent application of the instant applicant) was filed jointly by four inventors Christopher Albright, Claude McFarlane, Ric Joraulien and William Knight.

B. After allowance of 09/562,167, an amendment under 37 CFR 1.312 was filed canceling claims 20-23, 41 and 42, along with a petition to change inventorship, stating that William Knight is the sole inventor. The petition was signed by Christopher Albright, Claude McFarlane, Ric Joraulien, who each indicated that their invention was no longer being claimed. Generally speaking, the claimed subject matter solely invented by William Knight was a mixer which broadly recited an auger, while the canceled claims were directed to the same mixer but with a more specifically recited auger.

C. The three above mentioned deleted inventors, Christopher Albright, Claude McFarlane, Ric Joraulien (without William Knight) filed application No. 09/951,394 claiming exactly that which was canceled after allowance from 09/562,167.

D. Of the three deleted inventors, Claude McFarlane and Ric Joraulien (without William Knight and without Christopher Albright), filed the instant application, 09/808,592. The instant application, appears to claim all the subject matter claimed in 09/951,394 and all the subject matter that was canceled after allowance from 09/562,167.

E. In paper No. 9 of the instant application, applicant states that the instant invention was made jointly by Claude McFarlane and Ric Joraulien "at the same time as" the sole invention of William Knight (discussed above in paragraph B) was made.

F. In paper No. 9 of the instant application applicant states that while Ric Joranlien and Claude McFarlane were under contractual obligation to assign the instant invention to Knight Manufacturing Corporation at the time the invention was made, William Knight was not under any such contractual obligation. Christopher Albright was not discussed by applicant in this regard.

Issues to be Resolved

As stated of subsection 102(f) in *Pannu v. Iolab Corp.* 47 USPQ2d 1657 (CA FC 1998), "this subsection mandates that a patent accurately list the correct inventors of a claimed invention". While there is every reason to believe that Claude McFarlane and Ric Joraulien are inventors of the claimed subject matter of the instant application, based upon the background information outline above, there appear to be two important issues to resolve. Firstly, was Christopher Albright also a joint inventor of the at least some of the claimed subject matter of the instant application? And secondly, was William Knight a joint inventor of the at least some of the claimed subject matter of the instant application?

Discussion and Conclusion

Regarding the issue of whether Christopher Albright is a joint inventor of the claimed invention, there are two pieces of evidence that he is such a joint inventor. Firstly, Christopher Albright, Claude McFarlane and Ric Joraulien jointly filed Application No. 09/951,394, all the subject matter of which is now claimed in the instant application. Secondly, the same subject matter was cancelled from 09/562,167 together with a petition to change in inventorship by deleting Christopher Albright, wherein the petition

explicitly stated that the deletion of Christopher Albright "is necessary as result of cancellation of the following claims: claims 20-23 and 41-42". Together, these two separate pieces of evidence, unless rebutted, require one to conclude that Christopher Albright is a joint inventor of the claimed invention.

Regarding the issue of whether William Knight is a joint inventor of the claimed invention, it is initially noted that the grand-parent application (09/562,167) was filed jointly by Christopher Albright, Claude McFarlane, Ric Joraulien and William Knight. While applicant admitted in paper No. 12 of 09/562,167 that William Knight was the sole inventor of the issued claims of 09/562,167, no explanation of what William Knight *jointly* invented with any of the other inventors has been provided. Generally speaking, the instant claims recite the invention of William Knight, but with a more specific auger. For example, comparing instant claim 40 to claim 42 of US 6,409,376 issued solely to William Knight, both require a mixer comprising a container including a housing; a wall extending from the housing and defining an opening disposed remote from said housing, the arrangement being such that said housing and said wall define therebetween an enclosure; an auger disposed within the enclosure; a frame for supporting said housing, a plurality of wheels secured to the frame including a first wheel and second wheel spaced from and coaxial with the first wheel, a hitch bar, a first load cell between the first wheel and the frame, second load cell between the second wheel and the frame, and a third load cell secured to the hitch, a rotatable clevis, and a horizontal, intermeshing drive pinion and final drive wheel, the final driven wheel being connected to and rotating about the axis of the auger. However, the instant claims

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require a more specific auger. It was held in *Ethicon Inc. v. United States Surgical Corp.* 45 USPQ2d 1545 (CA FC 1998) that, in a claim to an apparatus comprising six elements (each express in means-plus-function language) a person who contributed to one alternative of one of the six elements was a joint inventor. In the instant case, with William Knight having (as admitted by applicant) solely invented so many of the claimed elements, one must conclude that he is (at least) a joint inventor of the claimed subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-20, 22-24, 26-28, 30-39 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted (see Background paragraph B above) invention of sole inventor William Knight (as claimed in 6,409,376), qualifying as prior art under 102(f) and/or 102(g), because applicants admit that they did not invent said invention, in view of Behrens (US 3,421,740). Regarding instant claims 1 and 2, claim 1 of Knight ('376) discloses essentially word for word all the limitations of instant claims 1 and 2, including "an auger disposed within said enclosure, said auger having an axis of rotation extending substantially vertically through said housing", except for the further auger limitations. Claim 17 of Knight ('376) further discloses that the "auger includes: a core; flighting connected to said core so that when said auger rotates, feed disposed

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within said enclosure is mixer"; however, the claims of Knight ('376) do not disclose the further auger limitations of instant claim 1. Behrens ('740) teaches augers having first and second staggered portions, the first portion having first and second ends, the second portion having first and second extremities (see Fig. 2; col. 1, lines 15-23 and 33-41, 54-57; col. 2, lines 23-72; and col. 3, lines 24-48). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the auger of Knight ('376) with staggered portions because Behrens ('740) explains that staggered portions provide improved agitation through "boiling and tumbling action" (see col. 1, lines 15-23 and 33-41, 54-57; col. 2, lines 23-72; col. 3, lines 24-48). The further limitations of instant claims 3-5 and 6-16 are disclosed word for word in claims 2-4 and 6-16, respectively, of Knight ('376). The further limitations of instant claim 17 are disclosed word for word in claim 20, of Knight ('376). The cylindrical and conical cores required by instant claims 18 and 19 are disclosed by claims 18 and 19, respectively, of Knight ('376). Regarding instant claim 20, Behrens ('740) teaches overlapping portions (see Fig. 2). Regarding instant claim 22, Behrens ('740) teaches first and second paddles (46,52,46A,52A). Regarding claim 23, Behrens ('740) teaches parallel first and second portions (42, 48). Regarding claim 24, Behrens ('740) teaches diverging first and second portions (44, 48). The further limitations of instant claims 26-28, 30-39 and 42 are disclosed essentially word for word in claims 21-23, 24-33 and 5 respectively, of Knight ('376). Regarding claim 43, Behrens teaches that a helical path followed by a second portion is spaced relative to that of a continuation of the first portion (see Fig. 2). The requirement of claim 44, that the container be truck mounted is disclosed by claim 3

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of Knight ('376). Regarding instant claim 45, claim 35 of Knight ('376) differs from instant claim 45 in two respects. Firstly, instant claim 45 requires pulley and belts rather than chains and sprockets; however, applicant admits on page 14, lines 1-5 of the instant specification that pulley/belt arrangements are art recognized equivalents of sprocket/chain arrangements. Secondly, instant claim 35 of Knight ('376) recites (in parent claim 34) "an auger disposed within said enclosure, said auger having an axis of rotation extending substantially vertically through said housing", the further auger limitations of instant claim 45 are not disclosed, although claim 17 of Knight ('376) further discloses that the "auger includes: a core; flighting connected to said core so that when said auger rotates, feed disposed within said enclosure is mixer". Behrens ('740) teaches augers having first and second staggered portions (see Fig. 2; col. 1, lines 15-23 and 33-41, 54-57; col. 2, lines 23-72; and col. 3, lines 24-48). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the auger of Knight ('376) with staggered portions because Behrens ('740) explains that staggered portions provide improved agitation through "boiling and tumbling action" (see col. 1, lines 15-23 and 33-41, 54-57; col. 2, lines 23-72; col. 3, lines 24-48).

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the sole invention of William Knight in view of Behrens ('740) as applied to claim 19 above, and further in view of Safely (US 384,719). The canting of flighting according to the further limitations of claim 25 is not disclosed by the sole invention of William Knight or by Behrens ('740). Safely ('719) teaches helical flighting of an auger being canted toward a housing (see Figs. 1 and 2; page 1 lines 24-29, 55-59 and 72-102). It is considered

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that it would have been obvious to one of ordinary skill in the art to have canted the
flighting in the manner taught by Safely ('719) because Safely ('719) explains that such
a flighting construction facilitates circulation of material (see page 1, lines 24-29 and 72-
78).

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 2, 17 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21 of copending Application No. 09/951,394. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 21 of 09/951,394 includes all the limitations of instant claims 1, 2, 17 and 30.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 26 and 31 are also provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 21 of

copending Application No. 09/951,394. Instant claims 26 and 31 depended from claims 2 and 30, respectively, discussed in the immediately-above paragraph. It is considered that the additional requirement that the final driven wheel be a "gear wheel" would have been implied or suggested to one of ordinary skill in the art by the limitations of claim 21 of 09/951,394, specifically, the requirement that the final driven wheel intermesh with a drive pinion. Likewise, the further requirements of instant claim 31 are considered to be implied or suggested by the requirement that the final driven wheel intermesh with a drive pinion.

14. Applicant is advised that should claim 2 be found allowable, claim 30 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). It is considered that independent claim 1 (from which 2 depends) as amended already requires all the further limitations of claim 30, though the limitations are worded differently.

Response to Arguments

15. Applicant's arguments have been considered but are moot in view of the new grounds of rejection.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

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A handwritten signature in cursive script, appearing to read "David Sorkin".

David Sorkin

June 17, 2003

A handwritten signature in cursive script, appearing to read "Charles Cooley".

CHARLES E. COOLEY
PRIMARY EXAMINER